

REMARKS

Interview

Applicants appreciate the courtesy Examiner O'Connor and Examiner Woods extended to Mr. Ray Ling and the undersigned on behalf of the Applicants on March 10, 2011. The matters discussed included Applicants' entitlement to the benefit of priority and potential claim amendments. By the response below Applicants adopted Examiner O'Connor's suggested amendments as reflected in claims 220, 223, 225, and 261, and Examiner Woods' suggested amendment as reflected in claim 320 (reciting cost).

Priority

The Office Action asserts that the pending claims are not entitled to the benefit of any priority earlier than January 23, 2004, the actual filing date of this Application. The undersigned provided citations in June of 2010 and a claim chart in October of 2010 that established Parent Application 09/571,650 satisfies the enablement and written description requirements of the 35 U.S.C. 112, first paragraph, for the pending claims. See M.P.E.P. § 201.11 and § 706.02 and Response and Request for Reconsideration June 9, 2010 and October 12, 2010.

The sole basis for the contention that the claims are not entitled to the benefit of priority is reproduced below:

For the purposes of Examination, claims 200, 223-239 and 261 have an effective filing date of 01-23-2004. The Double Patenting is being upheld. In Application No. 09/571,650, filed 05-15-2000, the method and system claims are narrow in description and comprise of; a web site, use of internet, monitoring vehicle operating characteristics in unit of risk during a period of time and storing the operating characteristics in unit of risk for the purpose of deciding insurance costs. The broad claims of this CIP case simply monitor and search the stored level of risk among a network of vehicle operators, of which is included in both the Burge and Tobey references. Paper 20101220, pg. 2, under "*Priority*"

Neither the contested double patenting rejection nor the contested claim rejections under 35 U.S.C. § 103 are relevant to perfecting the benefit of a priority claim under 35 U.S.C. § 120. See M.P.E.P. § 201.11 and § 706.02. Claims are entitled to the priority date of an earlier-filed application if it "indicate[s] to persons skilled in the art that as of the earlier date the applicant had invented what is

now claimed" using the written description standard of 35 U.S.C. § 112, first paragraph. *Eiselstein v. Frank*, 52 F.3d 1035, 1038 (Fed. Cir. 1995). The "earlier application [need only] show [] the subject matter that is claimed in the later application, with adequate direction as to how to obtain it." *Kennecott Corp. v. Kyocera Int'l, Inc.*, 835 F.2d 1419, 1422 (Fed. Cir. 1987). The proper inquiry is whether the disclosure reasonably conveys that the inventor had possession of the claimed invention. *Cordis Corp. v. Medtronic Ave., Inc.*, 339 F.3d 1352, 1364 (Fed. Cir. 2003).

The Office Action does not dispute Applicants' prior support of its claim for priority nor raise any questions regarding the claim chart demonstrating that the claims are fully supported by Parent Application 09/571,650 that was discussed in person. As demonstrated by the following table, the substance of the pending claims is fully supported by the disclosure of Parent Application 09/571,650 (U.S. 6,868,386).¹ Other portions of the specification not specifically cited as well as the other priority documents also provide support for the rejected claims. The references to Parent Application 09/571,650 (U.S. 6,868,386) are of the form **column:lines**.

Claims	Parent Application 09/571,650 (U.S. 6,868,386) Support
200	1:24-34; 4:30-58; 5:27-42; 7:61-63; 13:36-45; Figs. 2, 5 & 6
223	1:24-34; 4:30-58; 5:27-42; 7:44-69; 13:36-42; Figs. 2, 3, 5, & 6
224	1:24-34; 4:30-58; 5:27-42; 7:44-49; 13:38-42; Figs. 5 & 6
225	1:24-34; 4:30-58; 5:27-42; 7:61-63; 13:37-42; Figs. 5 & 6
261	1:24-34; 4:22-58; 5: 27-28; 7:44-8:6; 10:53-58; 12:15-23; 13:36-42, Fig. 2, 5 & 6

The Parent Application 09/571,650 (U.S. 6,868,386) demonstrates a constructive reduction to practice of the inventions recited in the pending claims at least as early as May 15, 2000. This effectively removes the Burge and Tobey references as prior art.

Double Patenting Request Rejection Held in Abeyance

Since there are no allowed claims and because the factual findings underlying this rejection are in error (as explained below), Applicants' Representative respectfully request that the rejection be held in abeyance.

Alternately, Applicants respectfully request withdrawal of these grounds of rejection. The Office Action makes the following factual findings to support its double patenting rejection:

¹ Applicants appreciate Examiner O'Connor's acknowledgement that citations supporting the independent claims would be sufficient to address this rejection.

The Double Patenting Rejection is being upheld. In Application No. 09/571,650, [U.S. **6,868,386**] filed 05-15-2000, the method and system claims are narrow in description and comprise of; a web site, use of internet, monitoring vehicle operating characteristics in unit of risk during a period of time and storing the operating characteristics in unit of risk for the purpose of deciding insurance costs.

The broad claims of this CIP case simply monitor and search the stored level of risk among a network of vehicle operators [.]

February 22, 2011, Office Action pg. 2, under “**Priority**”

However, this reasoning does not support this rejection because the Office Action asserts that the conflicting claims originated from U.S. 5,797,134 and U.S. 6,064,970 (and **not U.S. 6,868,386**).

The Office Action asserts:

1. Claims 200, 223-225 and 261 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 12 and 25 of U.S. **Patent No. 5,797,134**. Although the conflicting claims are not identical, they are not patentably distinct from each other because the tracked "vehicle operating states and driver actions", "trigger event" has the same meaning and usage as "track vehicle data and levels of risk".

2. Claims 200, 223-225 and 261 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 5 and 6 of U.S. **Patent No. 6,064,970**. Although the conflicting claims are not identical, they are not patentably distinct from each other because the tracked "operating state of a vehicle", "preselected relationship to the safety standards" has the same meaning and usage as "track vehicle data and levels of risk".

February 22, 2011, Office Action pg. 4, under “**Double Patenting**”

In short, U.S. 6,868,386 has no applicability to the pending double patenting rejection. The pending double patenting rejection cites *only* to issued claims 12 and 25 in U.S. 5,797,134 and issued claims 5 and 6 of U.S. 6,064,970. February 22, 2011 Office Action, #1 and #2 at page 4. The pending claims are not rejected for double patenting based on the claims of U.S. 6,868,386.

It should be noted that the Office Action does not provide the necessary factual findings or reasoned explanations that are required to support an obviousness rejection. MPEP § 804

(explaining obviousness double patenting determination parallels the guidelines for a 35 § U.S.C. 103(a) that include factual findings). Besides citing to a patent not relied on for its double patenting rejection, simply stating that four phrases, “vehicle operating states and driver actions,” “trigger event,” “operating state of a vehicle” and “preselected relationship to the safety standards,” have only one meaning and one usage (purportedly meaning “track vehicle data and levels of risk²”), does not provide a reasoned explanation or a citation of facts to support such a conclusion. Since rejections for obviousness cannot be sustained by mere conclusory statements, Applicants respectfully request withdrawal of this rejection. MPEP § 2141 and 2143; Examination Guidelines Update: Developments in the Obviousness Inquiry After KSR v. Teleflex, (Fed. Reg. Vol. 75, No. 169) at pg. 53645-53649 (recognizing that “obviousness cannot be sustained by mere conclusory statements”).

35 U.S.C. § 103

Claims 200, 223 – 239, 261 and 262 stand rejected under Tobey (U.S. Patent 6,714,894) in view of Burge³ (U.S. Patent Publication 2002/0111725). Because the pending application contains a specific reference to Parent Application 09/571,650 (U.S. 6,868,386), was filed before Parent Application 09/571,650 issued, and is supported by Parent Application 09/571,650’s written description, the claimed inventions pre-date the Tobey and Burge references. Since the cited references are not prior art under 35 U.S.C. § 102 or 35 U.S.C. § 103 to the pending independent claims, the cited references alone cannot render the pending dependent claims obvious.

Applicants respectfully requests the withdrawal this rejection.

² There is no support for the assertion that the four phrases share “a common meaning and usage.” For example, a portion of the Written Description of Application 08/592,958 (U.S. 5,797,134) indicates that ““Trigger events” are defined as a combination of sensor data requiring additional action or which may result in a surcharge or discount during the insurance billing process.” Neither the claims nor written description of Application 08/592,958 define the “Trigger events” as “track vehicle data and levels of risk” or suggest it is as an obvious variation or common usage. See Application 08/592,958 (U.S. 5,797,134) Col. 8, 63-65.

³ Burge acknowledges at least some of Applicants’ priority applications were known prior to Burge’s invention. Burge Application 09/907,545, ¶0043 – ¶0047 at 2.

Conclusion

In view of the remarks above, Applicants respectfully submit that the claims are in condition for allowance. If any issues remain, Applicants request that Examiner call the undersigned to expedite the prosecution of the application.

Respectfully submitted,

/James A. Collins/

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, ILLINOIS 60610
(312) 321-4200

James A. Collins
Registration No. 43,557
Attorney for Applicants